



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,013	07/25/2003	Daniel Dietzel	3401-138	3993

7590 03/26/2007
Thomas C. Pontani, Esq.
Cohen, Pontani, Lieberman & Pavane
Suite 1210
551 Fifth Avenue
New York, NY 10176

EXAMINER

ARAJ, MICHAEL J

ART UNIT	PAPER NUMBER
----------	--------------

3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/628,013	Applicant(s) DIETZEL ET AL.	
	Examiner Michael J. Araj	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12,17-21 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12,17-21 and 25-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims 12 and 17-21 and 25-30 are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12, 17-21, and 25-30 are rejected, as understood, under 35 U.S.C. 102(e) as being anticipated by Abdelgany et al. (U.S. Publication No. 2002/0082604).

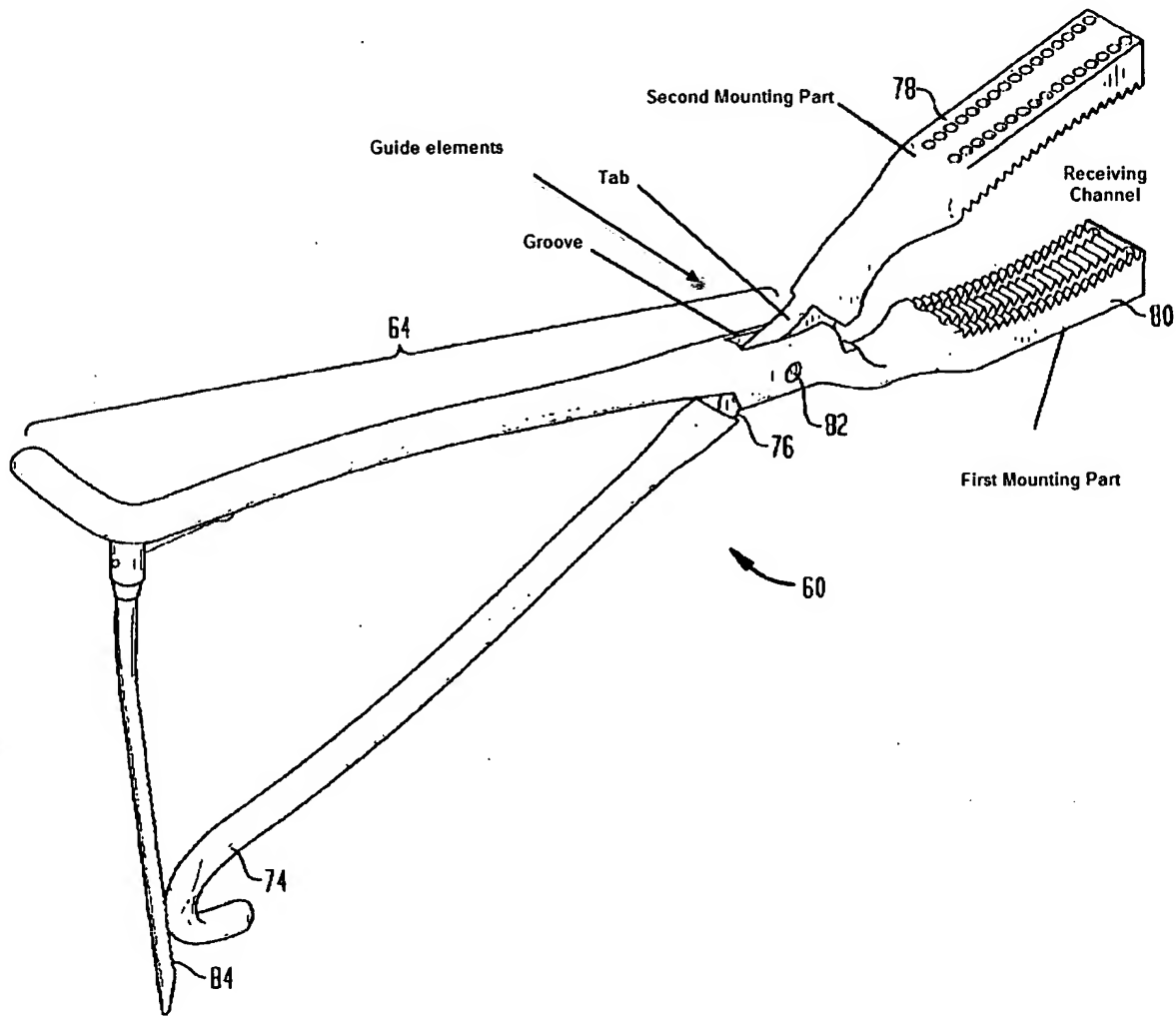
Abdelgany et al. disclose a device that includes a first mounting part defining a receiving channel that has a longitudinal axis and the mounting part further defines at least one slot (See Fig. 7C) therethrough at an angle oblique to the longitudinal axis of the receiving channel. The first mounting part defines two intersecting slots in the region of the receiving channel each having an acute but different angles relative to the longitudinal axis of the receiving channel, where the second mounting part receivable on the first mounting part has at least one slot arranged. It can also be seen that the

Art Unit: 3733

first and second slots fall within the range of being between 4 and 13 degrees. The second mounting part also defines a receiving channel where the first and second mounting parts face each other when second mounting part is received on first mounting part (see Figure 1 below) and are receivable on each other. There are also grooves in the receiving channel can also be seen as being V-shaped which also gives rise to that surface being roughened. Abdelgany et al. also discloses that each first and second mounting parts include guide elements positioning the parts relative to each other such that the slots and receiving channels face each other and are arranged congruently. These guide elements can be considered normal to the longitudinal axis of the receiving channel if the longitudinal axis of the receiving channel is defined as perpendicular to the entire length of the device. Also in looking at the slots in Fig. 7C it can be seen that these slots are configured so that an extent of each of said first and second slots in a direction of the longitudinal axis of the channel is greater than an extend of the each of the first and second slots in a direction transverse to the longitudinal axis of the channel. With regard the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Abdelgany et al., which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which

Art Unit: 3733

a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

**Figure 1**

Claims 12, 17, 21 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Hilburn (U.S. Patent No. 3,596,898).

Hilburn discloses a device that includes a first mounting part (12) defining a receiving channel that has a longitudinal axis and the mounting part further defines at least one slot (27) therethrough at an angle oblique to the longitudinal axis of the receiving channel (see Figure 2 below) having a V-shaped cross section. A second mounting part (11) receivable on the first mounting part has at least one slot (26) arranged so as to be congruent to the slot of the first mounting part. The second mounting part also defines a receiving channel where the first and second mounting parts face each other when second mounting part is received on first mounting part. Hilburn also discloses that each first and second mounting parts include guide elements positioning the parts relative to each other such that the slots and receiving channels face each other and are arranged congruently. Said guide elements of said first mounting part comprise of grooves and said guide elements of said second mounting part comprise tabs receivable in said grooves. The tabs and grooves extend in a longitudinal axis that is normal to the longitudinal axis of the receiving channel and normal to the surface on which the receiving channel is defined (see Figure 2 below).

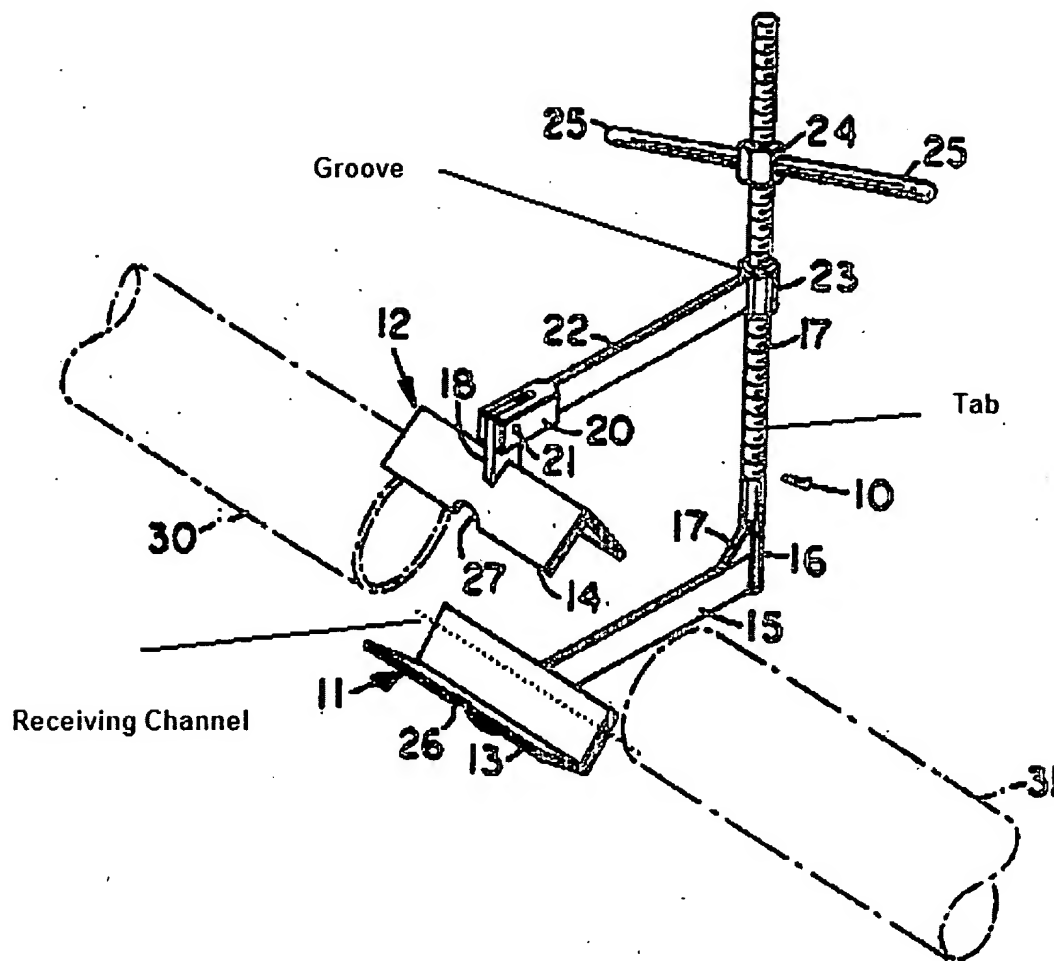


Figure 2

Response to Arguments

Applicant's arguments filed on December 11, 2006 have been fully considered but they are not persuasive. With regard to Abdelgany not having slots "configured to guide a saw blade introduced through said slots for cutting a bone piece received in said receiving channel to a predetermined wedge shape usable for displacement osteotomy is not persuasive. In response to applicant's argument that Abdelgany not having slots "configured to guide a saw blade introduced through said slots for cutting a bone

Art Unit: 3733

piece received in said receiving channel to a predetermined wedge shape usable for displacement osteotomy", it is noted that the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). The device of Abdelgany and Hilburn can fully function in the matter disclosed in claim 12 of the applicant.

With regard to Hilburn not disclosing a mounting part with first and second slots, as stated in the rejection above, 12 and 11 are considered mounting parts, and 26 and 27 are considered slots, therefore anticipating the applicant's claims. In response to applicant's argument that Hilburn discloses a pip holder, again it is noted that the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

The arguments with respect to the newly added claims are addressed in the action above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Araj whose telephone number is 571-272-5963. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MJA



EDWARD C. ROBERT
SUPERVISORY PATENT EXAMINER